REMARKS

The issues outstanding in this application are as follows:

- Claims 7 and 9 are rejected under 35 U.S.C. § 102(e);
- Claim 11 is rejected under 35 U.S.C. § 103(a); and
- Claim 10 is rejected under 35 U.S.C. § 103(a).

Claim amendments

Claims 7 and 11 have been amended in order to more clearly define the subject invention. Amended independent claim 7 now recites a package having first and second sheets of a compostable sheet material in which each include a compostable substrate layer, an intermediate or first sealing layer having a relatively high sealing initiation temperature and a second or surface sealing layer having a relatively low sealing initiation temperature. The two sheets of sheet material are bonded together in face-to-face relationship around a periphery with the substrate layers being outermost. The high sealing initiation temperature of the first sealing layer and the low sealing initiation temperature of the second sealing layer provides for a package having different sealing properties between the first and second sealing layers in different regions spaced around the package periphery such that a sealing strength around the periphery can be controlled depending on whether sealing takes place through the second sealing layer only or whether sealing takes place through both sealing layers in the different regions of the periphery. Claim 11 includes the same limitations. No new matter has been added.

35 USC § 102(e)

Claims 7 and 9 are rejected under 35 U.S.C. § 102(e) as being anticipated by Tankersley (U.S. Patent No. 6,957,915) as evidenced by Hanyu *et al.* (U.S. Publication No. 2002/0176974). Applicant respectfully traverses this rejection.

Tankersley is directed to a standup bag manufactured from a co-extruded multi-layered heat sealable film. A single piece of heat sealable film, having top and bottom edges and first and second side edges, is continuously formed into a front wall, two side walls, and

a rear wall. The rear wall is closed by heat sealing the first and second side edges to each other. The top portion is sealed by heat sealing the top edge and the bottom portion is sealed by heat sealing the bottom edge. The heat sealable film 30 is manufactured with an inside layer that has a lower seal initiation temperature than the outer layer. The inside layer 35 is sealed to itself at the sealing area 34. Heat must be applied to the outer layer 36 at a temperature higher than the melting point of the inside layer 35. The heat must be applied at or above the melting point of the outer layer 36 to seal ear sections 38, 39, but below the temperature at which the outer layer 36 is destroyed. As shown in Fig. 9, the packaging of Tankersley has regions in which the film is bonded back-to-back and regions where the film is bonded face-to-face.

The Hanyu references is directed to heat-seal polymer film and method of forming such film. The heat-seal film is formed from metallocene-catalyzed isotactic random copolymers of propylene and at least one other C.sub.2 to C.sub.8 alpha olefin, such as ethylene random. Hanyu teaches that heat-seal strength is often measured in terms of "hot-tack" performance and hot tack refers to the strength of the semi-molten seal at the interface between two film surfaces.

Anticipation of a claim is only established where "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed.Cir. 1987), Applicant asserts that Tankersley fails to teach all elements of independent claim 7. This is because the Tankersley reference does not disclose a package having first and second sheets of a compostable sheet material in which each include a compostable substrate layer, an intermediate or first sealing layer having a relatively high sealing initiation temperature and a second or surface sealing layer having a relatively low sealing initiation temperature. The two sheets of sheet material are bonded together in face-to-face relationship around a periphery with the substrate layers being outermost. The high sealing initiation temperature of the first sealing layer and the low sealing initiation temperature of the second sealing layer provides for a package having different sealing properties between the first and second sealing layers in different regions spaced around the package periphery such that a sealing strength around the periphery can be controlled depending on whether sealing takes place through the second sealing layer only or whether sealing takes place

through both sealing layers in the different regions of the periphery. In Tankersley, the inside layer has a lower seal initiation temperature than the outer layer, rather than the intermediate layer of claim 7. Additionally, the Tankersley reference does not provide for a film in which the high sealing initiation temperature of the first sealing layer and the low sealing initiation temperature of the second sealing layer provides for a package having different sealing properties between the first and second sealing layers in different regions spaced around the package periphery such that a sealing strength around the periphery can be controlled depending on whether sealing takes place through the second sealing layer only or whether sealing takes place through both sealing layers in the different regions of the periphery. The Hanyu reference does not cure the deficiencies of the Tankersley reference.

If an independent claim is not anticipated under 35 U.S.C. § 102(e) , then any claim depending therefrom is by definition not anticipated. Applicant respectfully submit that claim 9 depends at least in part from independent claim 7. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection of claims 7 and 9 under 35 U.S.C. § 102(e) as being anticipated by Tankersley (U.S. Patent No. 6,957,915) as evidenced by Hanyu *et al.* (U.S. Publication No. 2002/0176974).

35 USC § 103(a)

Claim 11 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Tankersley (U.S. Patent No. 6,957,915). Applicant respectfully traverses this rejection.

Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), controls the consideration and determination of obviousness under 35 U.S.C. 103(a); *KSR Int'l Co. v. Teleflex Inc.,* 127 S. Ct. 1727, 1734-35, 167 L. Ed. 2d 705, 715 (U.S. 2007). The four factual inquires enunciated therein for determining obviousness are: (1) determining the scope and contents of the prior art; (2) ascertaining the differences between the prior art and the claims in issue; (3) resolving the level of ordinary skill in the pertinent art; and (4) evaluating evidence of secondary considerations.

In this case, neither the level of ordinary skill in the art, nor secondary considerations are at issue. However, in order to assess the scope and content of the prior art properly, a thorough understanding of the invention must be acquired by studying Applicant's claims and

the specification. M.P.E.P. § 2141. Thus, the inquiry begins with construction of Applicant's claims. Next, when ascertaining the differences between the prior art and the claims at issue, both the invention and the prior art references as a whole must be considered, and ***all*** claim limitations must be considered when determining patentability of Applicant's invention. M.P.E.P. §§ 2141; 2143. When this is properly done in this case, as shown below, it becomes clear that differences exist that preclude obviousness. As shown below, this requirement is not met in this case, and no *prima facie* case for obviousness is made.

Applying the proper test to this case begins with amended independent claim 11 that requires the steps of: 1) providing a compostable sheet material comprising a compostable substrate layer, an intermediate or first sealing layer having a relatively high sealing initiation temperature and a second or surface sealing layer having a relatively low sealing initiation temperature; 2) placing two webs of the compostable sheet material together with the surface sealing layers in face-to-face relation; and 3) sealing the webs together around a periphery to form a package body, wherein the high sealing initiation temperature of the first sealing layer and the low sealing initiation temperature of the second sealing layer provides for the package to have different sealing properties between the first and second sealing layers in different regions spaced around said periphery such that a sealing strength can be controlled around the periphery depending on whether sealing takes place through the second sealing layer only or whether sealing takes place through both sealing layers in the different regions of the periphery.

The Tankersley reference does not teach a method of manufacturing the package that includes at least the step of sealing the webs together around a periphery to form a package body, wherein the high sealing initiation temperature of the first sealing layer and the low sealing initiation temperature of the second sealing layer provides for the package to have different sealing properties between the first and second sealing layers in different regions spaced around said periphery such that a sealing strength can be controlled around the periphery depending on whether sealing takes place through the second sealing layer only or whether sealing takes place through both sealing layers in the different regions of the periphery. As discussed above, in Tankersley the heat sealable film 30 is manufactured with an inside layer that has a lower seal initiation temperature than the outer layer and the inside layer 35 is sealed to itself at the sealing area 34. Heat must be applied to the outer layer 36 at

a temperature higher than the melting point of the inside layer 35. The heat must be applied at or above the melting point of the outer layer 36 to seal ear sections 38, 39, but below the temperature at which the outer layer 36 is destroyed. This is substantially different than the method of claim 11 in which the sealing strength can be controlled around the periphery depending on whether sealing takes place through the second sealing layer only or whether sealing takes place through both sealing layers in the different regions of the periphery. In order to make a proper *prima facie* case for obviousness, all claim limitations must be accounted for. M.P.E.P. § 2143.03. This rejection fails to consider all elements of the claims and their meaning. Thus, claim 11 is erroneously rejected over the Tankersley reference and Applicant respectfully requests the rejection be removed. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection of claim 11 under 35 USC 103(a) as having subject matter unpatentable over U.S. Patent No. 6,957,915 to Tankersley.

Claim 10 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Tankersley (U.S. Patent No. 6,957,915) in view of Jerdee et al (U.S. Patent No. 6,333,087). Applicant respectfully traverses this rejection.

Applicant respectfully submits that the previous discussion of the patentability of the current invention over the Tankersley reference obviates this rejection. The Jerdee reference adds no new teaching to the Tankersley reference that would result in the inventive package of amended claim 7. Claim 10 depends at least in part on amended independent claim 7. If an independent claim is non-obvious under 35 U.S.C. 103, than any claim depending therefrom is by definition nonobvious. *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Applicant respectfully asserts that because of its dependency from 7, claim 10 is nonobvious over these references. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection of claim 10 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,957,915 to Tankersley in view of U.S. Pat. No. 6,333,087 to Jerdee et al.

CONCLUSION

In view of the above, Applicant believes the pending application is in condition for allowance.

Applicants believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2375, under Order No. HO-P03292US0 from which the undersigned is authorized to draw.

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Respectfully submitted,

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